

**Serial No. 09/914,056**

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**Remarks**

Claims 22-44 are currently pending in the above-captioned matter. Claim 42 has been amended to correct the typographical error. Claims 22 and 30 have also been amended. Support for the amendments is found in the Examples and in the specification at pages 8, line 8-20 and page 9, line 12 to page 10, line 11. No new matter has been added. After entry of this amendment, claims 22-45 are pending, claims 22, 30 and 45 being independent. Remarks made herein are based on the claims as amended hereby.

**35 USC §102 and §103 Rejections**

Claims 22, 36 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,378,291 to Ara et al (the '291 patent).

Applicants respectfully traverse the rejection with regard to the claims, as amended. As the Office is no doubt aware, a rejection under 35 U.S.C. §102 can only be maintained if single reference teaches each and every element of the claims. The Examiner cannot ignore any differences between the claims and the reference. If there are any differences whatsoever between the reference and the claim(s), the rejection cannot be based on 35 U.S.C. §102. Titanium Metals Corp. v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Independent claims 22, 30 and 45 recite features that are not taught by the '291 patent. The '291 patent requires the composition used to have a pH of 5 or less, see the '291 patent, col. 2, line 54 and col. 6, line 27-43. The '291 patent also requires that no ionic surfactants be used and teaches nonionic surfactants which do not include silicone. Claims 22 and 30 recite pHs of at least 6.5 and from 7-11, respectively. Likewise, independent claim 45 recites surfactants that are not taught by the '291 patent. Accordingly, the rejection under 35 USC §102 should be withdrawn.

Claims 23-35, 37-40 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,378,291 to Ara et al (the '291 patent). Applicant respectfully traverses the rejection with respect to the claims as amended. As

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discussed in the previous paragraph with reference to the §102 rejection, claims 22, 30 and their dependent claims are patentably distinct from the prior art.

In order to support a rejection under 35 U.S.C. §103, the Office must establish that there was some suggestion, either in the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, "[s]omething in the prior art as a whole must suggest the desirability, and, thus, the obviousness, of making" the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

There is no teaching or suggestion in the '291 patent to use the pH ranges recited in the claims, and as discussed above, the reference teaches against the pHs recited in Applicants' claims 22 and 30. Likewise, there is no teaching or suggestion in the '291 patent of Applicants' selection of surfactants. The '291 patent fails to recognize the problems of cracking and blocking that Applicants are seeking to solve. The nonionic surfactants taught by the '291 patent are typical surfactants used in polymerization of monomer. There is no mention of the surfactants of the '291 patent being useful in other than for emulsion-making. Nothing in the '291 patent suggests the desirability or how to modify the '291 teachings to achieve Applicants' invention. There is no teaching or suggestion in the '291 patent of the anionic or silicone containing surfactants claimed by Applicants. Accordingly, Applicants respectfully request that the rejection under 35 USC §103(a) be withdrawn.

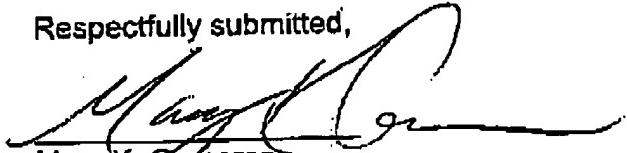
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Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. The Commissioner is hereby authorized to charge all fees necessary for entry of this amendment to Deposit Account No. 01-1250. Applicants submit that the claims are in condition for allowance and a notice to the effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned.

Respectfully submitted,



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